

**REMARKS**

**I. Status of Claims**

Claims 42-62, and 65-119 are pending in this application, with claims 54-59 and 88-119 withdrawn, as directed to non-elected subject matter. See Office Action at 2. Without prejudice or disclaimer, claims 63 and 64 are cancelled herein, and claim 1 is amended. Claim 42 is amended to add “at least one microwax in the form of small particles ranging from 0.5 to 30  $\mu\text{m}$ .” Exemplary support for this amendment can be found in the as-filed specification at page 20, ll. 15-25.

Claim 42 is further amended to add “wherein the total wax content ranges from 25% to 70% by weight, relative to the total weight of the composition.” Exemplary support for this amendment can be found in the as-filed specification at page 21, ll. 26-31, and cancelled claims 63 and 64. Moreover, Applicants note that the range of total wax content (i.e., 10% to 70%) disclosed in the as-filed specification inherently supports the narrower sub range now claimed (i.e., 25% to 70%). See M.P.E.P. § 2163.05(III) (“With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure”) (citing *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) holding that a limitation to “between 35% and 60%” did meet the description requirement, when the original specification included a range of “25%-60%” and exemplary points at 36% and 50%)).

In addition, the broad disclosure of from 10% to 70%, along with the explicitly recited narrower disclosures of the exemplary ranges within the broad disclosure (i.e., 15% to 65%, 20% to 60%, and 25% to 55%), allows for the claimed sub-range to meet the written description requirement. Accordingly, no new matter is added by the amendments presented herein, and Applicants respectfully request their entry.

**II. Rejection under 35 U.S.C. § 103(a)**

**A. Claims 42-53, 60-73, and 75-87**

The Office rejects claims 42-53, 60-73, and 75-87 under 35 U.S.C. § 103(a) as allegedly “being unpatentable” over U.S. Patent No. 6,264,933 or EP 1013256 (collectively, “the ‘933 patent”). Office Action at 2. The Office contends that the ‘933 patent “discloses waxes . . . film forming polymers, thickeners, auxiliary film-forming polymers, and all these belong to ‘solids content’ and the addition of the weight percent of all these ingredients (higher weight percent) meet the limitations of claims 1-4.” Office Action at 3 (emphasis omitted). The Office concludes that “it would have been obvious to one of ordinary skill in the art . . . to prepare compositions taught by patent ‘933 using wax, film former, non-aqueous phase, additional film former, volatile oil expecting the mascara compositions [to] exhibit good curling as well as [being] waterproof . . . .” *Id.* at 3-4. Applicants respectfully disagree and traverse the rejection. However, Applicants have amended claim 42 to recite that the cosmetic composition comprises “at least one microwax in the form of small particles ranging from 0.5 to 30  $\mu\text{m}$ .” To the extent, however, that the Office may consider rejecting amended claim 42

based on the rejection of record, Applicants respectfully disagree and traverse the rejection for the reason that '933 patent does not teach or suggest the present claims.

The key "to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." M.P.E.P. § 2141(III). The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006). Applicants respectfully submit that such articulated reasoning is not present because the Office fails to consider the '933 patent in its entirety and instead, selects components from the '933 patent to support the conclusion of obviousness. M.P.E.P. § 2141.02(VI) (a prior art reference relied upon in a rejection "must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention").

Claim 42, as-amended, recites that the composition comprises, *inter alia*, at least one microwax in the form of small particles ranging from 0.5 to 30  $\mu\text{m}$ . The '933 patent, in contrast, fails to teach or suggest a composition comprising at least one microwax in the form of small particles ranging from 0.5 to 30  $\mu\text{m}$ . Accordingly, in considering the '933 patent in as a whole, the '933 patent fails to guide one of ordinary skill in the art to the presently claimed compositions, because the '933 patent fails to teach all the elements of the present claims.

The '933 patent teaches compositions that comprise film forming polymers and lamellar polymers in amounts ranging from 0.05% to 10%, and 0.5% to 10%, respectively. '933 patent at col. 4, ll. 4-6 and col. 5, ll. 34-36. The compositions of the '933 patent can optionally comprise waxes (2% to 40%) and thickeners (0.5% to 10%). '933 patent at col. 7, ll. 8-17 and col. 8, ll. 48-49. Despite the fact that the '933 patent fails to guide one of ordinary skill in the art to select the "higher weight percent" of these components, the Office contends that such selection "would have been obvious." Office Action at 3.

Applicants respectfully submit that such arbitrary picking and choosing is improper. For example, following the Office's logic, one of ordinary skill in the art could just as easily pick the "higher weight percent" of the volatile oil (35% to 75%) disclosed in the '933 patent (col. 6, ll. 6-9). Subsequently, the amount of volatile oil would be greater than the total solids content, in contrast with the pending claims, which recite that the amount of volatile oil content is less than or equal to the amount of total solids content. See *e.g.*, claim 42, as-amended.

In fact, the '933 patent does teach a higher volatile oil content. The '933 patent (at col. 10, line 18 - col. 11, line 45) exemplifies four compositions comprising a volatile oil (isododecane) and solids (waxes, polymers, etc.). As summarized in the table below, *all* of the exemplary compositions in the '933 patent contain a total volatile oil content greater than the amount of the total solids content, as opposed to the instant

claims, which require a total volatile oil content less than or equal to the amount of the total solids content. See e.g., claim 42, as-amended.

Example	Solids Content	Volatile Oil Content
1	37.16%	53.9%
2	36.86%	54.2%
3	36.88%	57.2%
4	38.85%	55.1%

Therefore, the '933 patent, which fails to explicitly discuss any relationship between volatile oil content and total solids content in cosmetic compositions, and as shown above, exemplifies the opposite relationship than that claimed, would not have led one of ordinary skill in the art to the instant claims, i.e., wherein the total volatile oil content is less than or equal to the amount of the total solids content.

Accordingly, the rejection is improper and should be withdrawn.

**B. Claim 74**

The Office rejects claim 74 under 35 U.S.C. § 103(a) as allegedly “being unpatentable” over the '933 patent in view of U.S. Patent No. 5,959,009 (“the '009 patent”). Office Action at 4. The Office acknowledges that the '933 patent fails to teach compositions free of water and of water-soluble solvent, as recited in claim 74. Relying on the '009 patent, the Office contends that the '009 patent, particularly Example 1, “teaches mascara water proofing compositions using volatile oil and not using water.”

*Id.* The Office concludes that “it would be obvious . . . to prepare compositions taught by patent ‘933 . . . without water taught by patent ‘009 . . . expecting the mascara compositions exhibit good curling as well as water proof without using water taught by patent ‘009.” *Id.* Applicants respectfully disagree and traverse the rejection for the following reasons.

Claim 74, which depends from claim 42, embodies all of the claim limitations of claim 42. Irrespective of the fact that the ‘009 patent exemplifies a composition that does not contain water or water-soluble solvents, the ‘009 patent fails to remedy the deficiencies of the ‘933 patent. Specifically, the ‘009 patent fails to teach or suggest compositions comprising microwaxes as currently claimed. Moreover, the ‘009 patent fails to lead one of ordinary skill in the art to prepare compositions wherein the total volatile oil content is less than or equal to the solids content of said composition. Rather, Example 1 of the ‘009 patent, exemplifies a composition comprising 78.45% isododecane. Accordingly, the ‘993 and the ‘009 patents fail as a whole to render the claims obvious, and instead, would lead one of ordinary skill in the art away from preparing compositions wherein the total volatile oil content is less than or equal to the solids content of said composition. Therefore, the rejection is improper, and Applicants respectfully request its withdrawal.

**III. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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